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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 *Ex parte* JAMES B. MELESKY
11
12

13 Appeal 2009-004503
14 Application No. 10/024,478
15 Technology Center 3600
16
17

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19 Oral Hearing Held: October 6, 2009
20
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22 Before WILLIAM F. PATE, III, STEVEN D. A. McCARTHY and
23 STEFAN STAICOVICI, *Administrative Patent Judges*.
24

25 APPEARANCES:
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36 The above-entitled matter came on for hearing on Tuesday, October 6, 2009,
37 commencing at 9:00 a.m., at the U.S. Patent and Trademark Office, 600
38 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary Public.

P R O C E E D I N G S

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THE CLERK: Good afternoon. Calendar Number 4, Appeal No. 2009-004503. Mr. Janoski.

JUDGE PATE: Good morning, Mr. Janoski.

MR. JANOSKI: Good morning, Your Honor.

JUDGE PATE: First, I'd like you to introduce who you've got with you.

MR. JANOSKI: Yes, I was going to do that.

This is Kirk Damman. He's one of my partners at Lewis, Rice, Fingersh, whose name you probably saw all over the documents.

This is Mr. James Melesky, who is the inventor of the device we're going to be talking about this morning.

JUDGE PATE: Thank you very much.

MR. JANOSKI: You're welcome.

JUDGE PATE: We've had a chance to look over this case beforehand, so we're up to speed on the technology; so we'd like to hear your arguments about patentability.

MR. JANOSKI: Good morning, Your Honors. They say that necessity sometimes is the mother of invention, and this case is fairly straight forward, we believe, based on Claim 14, the only independent claim at issue.

I guess I'm going to go back to the roots of the PTO where it was required that a model of the invention be submitted to the Patent Office. What I have here is a scale model of the invention.

1 You will find this embodiment of it in Figure 1 and Figure 4 of the
2 application, at Exhibits A, B, G, V and GG, and referred to in the evidence
3 submitted to support Applicant's secondary consideration position.

4 So Claim 14 has many elements, and I think the visual would be very
5 important here. What we have here is an insulating cover which sits over the
6 opening of an attic.

7 The elements of it are a continuous frame, having sides and ends. We
8 have also a removable closure member. That has a central portion, which is
9 here, being sized and shaped to fit within the frame opening, and to fit
10 snugly within the frame opening here. That then forms a first continuous
11 seal within the frame of the device of the embodiment.

12 Then it has an upper portion. Here is the upper portion, which has
13 flanges extending laterally outward relative to the depending central portion,
14 and being sized and shaped to snugly engage the upper surface of the side
15 walls. Basically, it sits on top, and it fits in tightly. That forms a second seal
16 within the device.

17 The closure member, another element, is not hinged to and detaches
18 from the frame. So, basically, you can pick this up, when it is over the attic,
19 and just push it up against the seal.

20 Then wherein the first and second seal are generally orthogonal to
21 each other -- right angles, essentially -- it is in place.

22 This invention prevents both conductive and convective heat loss
23 because of its claimed first and second seal. I submit this invention is not
24 shown or suggested by either the Waters, et al. or Helbig references alone, or
25 in combination as the Examiner has suggested.

1 Twenty-seven years from the issuance of the two references -- both
2 references, interestingly enough, granted in 1982 -- the depending portion of
3 the lid or cover within the frame has never been used in the prior art, nor has
4 a device with two seals.

5 So let's look at Waters here. Waters is a cover for a hatch or pull-
6 down staircase. It has a frame, and the frame is shown in 20, 22, 24 and 26.
7 It also has what they call a sheet, which is hinged to one end of the frame, or
8 it can be integral to the frame on top. Now, this is to prevent heat loss. It
9 insulates and prevents heat loss, and the Examiner has admitted that it
10 doesn't show all the elements of Claim 14.

11 I would direct Your Honors to page 5 of the Examiner's Answer
12 where he sets forth the elements that are not shown there.

13 He states in part: "Does not show the closure member not being
14 bonded to any portion of the continuous frame" -- because it is hinged. "It
15 does not show a depending central portion being sized and shaped to fit
16 within the frame," and this will be important when we get to the next
17 reference, "opening defined by the frame and fictionally and snugly
18 engaging each of the side walls and end walls of the frame inside the
19 opening to create a first continuous seal on this."

20 He also says it doesn't show the first and second seals being generally
21 orthogonal to each other. So the question then becomes does Helbig provide
22 the missing features, and we submit that Helbig does not.

23 So if we look at Helbig, and I think for point of reference you look at
24 Figure 6. Figure 6 is a pull-down ladder.

1 Helbig uses the structure of the pull-down ladder there, or the
2 Examiner has used the structure of the pull-down ladder, to where it has one
3 frame. That frame is element 12.

4 It is rectangular, similar to this one here that we have in the device;
5 and then it is attached in place by two joists, two parallel joists, which are
6 26.

7 Now, you have here in Helbig -- it shows a single piece cap that uses
8 the frame of the pull-down stair, and its inner member, which is 24, rests on
9 top of the frame on the four sides. Not within the frame, but rests on top of
10 the frame.

11 You can see there in Figure 7 where it is shown best. You have the
12 frame 12, you have the element 24, it rests on top. It is not within the frame.
13 Additionally, there is a second element, which is 28, which rests on top of
14 element 24, and it sits, as shown in this, on the two joists. Not four joists,
15 but the two joists is what it has there.

16 This is also for conductive heat loss, and there is no suggestion or
17 motivation to place the inner flange or member within the frame of Waters.
18 As stated in Column 4, Lines 4 - 7 of the Helbig reference: "The use of the
19 two members is to create an additional insulation barrier," and you will see
20 that in 40 where there is an air space. Again, for conductive heat loss, not
21 for convective heat loss.

22 JUDGE MCCARTHY: But, Counsel, don't you nonetheless get two
23 different seals? One seal on the side of the inner member 24, and another
24 seal on the bottom of the outer member 28?

1 MR. JANOSKI: No, you don't because you do not have a continuous
2 frame, Your Honor. There is just two joists. You do not have a frame that
3 goes all the way around, so you do not create a seal.

4 JUDGE MCCARTHY: But don't you have the seal between the two
5 joists and the bottom of number 28?

6 MR. JANOSKI: No, you do not because on the other side there is no
7 seal. There is no seal. You have to have a continuous seal, and the claim
8 language requires a continuous seal around. You need the frame in order to
9 do that.

10 The joists are used there as a connector, and you have this air space,
11 but there is not a seal as required in the claim, or as claimed.

12 JUDGE MCCARTHY: What is it in the claim that requires us to have
13 a seal that goes all the way around the continuous frame?

14 MR. JANOSKI: If you look at the claim, it says: "Said frame fits
15 snugly, engaging such side walls and end walls of the frame, inside the
16 frame to create a first continuous seal within said frame."

17 Then as to the upper portion forming flanges, again: "Being sized and
18 shaped to snugly fit and snugly engage, and to create a second continuous
19 seal with said frame." So that's the language that requires that limitation,
20 that element to the claim in there.

21 A continuous seal either both within and with the frame. In this
22 embodiment, on top of the frame. So it's sitting on top.

23 Essentially, the seals are here on the side with the inside of the frame,
24 and with the flange on top, with the top of the frame.

1 Continuous, all the way around the frame, which is the language of
2 the claim, which is not shown, we would submit, in the Helbig reference. It
3 is not suggested, and there would be no motivation for one of ordinary skill
4 seeing this to really come up with this device, this embodiment, this claim to
5 do this.

6 So we do not believe -- you know, we believe the structure of the
7 claim is not in the combinations of these two references at all. I think it's a
8 tribute to the Appellant's ingenuity that he essentially improved on both
9 Waters and Helbig.

10 But there is no case here for obviousness based on the two references
11 cited by the Examiner. It does not disclose -- neither disclose individually or
12 in combination -- Appellant's claimed invention as set forth in Claim 14.
13 Now, admittedly, this is a relatively simple device. It really is. I think
14 sometimes it may be hard, looking at the two references, that this is obvious;
15 but the question becomes why in 20 years, Melesky applied for his patent
16 application in December of 2001 --

17 JUDGE MCCARTHY: Actually, Counsel, if I may, before you move
18 on -- do you happen to recall whereabouts in your Briefs the argument
19 concerning there not being a continuous seal around the devices occurred?

20 MR. JANOSKI: I know it is in both our initial Brief and also pointed
21 out in our Reply Brief, specifically about the continuous seals.

22 If this is simple and obvious, then I guess the question is why didn't
23 for many years Owens, Corning, U.S. Department of Energy, U.S. Home
24 Builders Association, the National Weatherization Assistance Program in
25 conjunction with Oak Ridge Laboratory, weatherization programs

1 throughout the country, experts in the industry -- why didn't they come up
2 with this solution over 27 years?

3 As a matter of fact, many of them found the results -- they were
4 skeptical about this. Mr. Melesky is an individual. He doesn't have a big
5 background in this industry. But they found that the results that were
6 achieved were surprising.

7 We have, and these are all within the exhibits, Exhibit M, Doug Rye,
8 who has 35 years experience in residential energy efficiency, and is a
9 consultant with the U.S. DOE Energy Services, says the Energy Guardian
10 kits set a national standard.

11 Vic Aleshire, which is the second --

12 JUDGE MCCARTHY: Counsel, if I may, what evidence is there in
13 the record that there has, in fact, been a long-felt need for 27 years for this
14 invention?

15 MR. JANOSKI: The long-felt need has been stated within these
16 references that there has been a loss of energy through this particular attic
17 opening.

18 The long-felt need is that these references are 1982, and that was the
19 state of the art. Now we come up with an invention that has gotten results
20 that the experts did not believe were attainable. Where they thought maybe
21 with a covering over the hatch you could get a reduction or improvement of
22 100 cfm, but --

23 JUDGE MCCARTHY: But there's nothing in the record before us
24 predating the inventor's conception which would indicate there was, in fact,
25 a felt need in the art for an improvement.

1 MR. JANOSKI: I would submit, Your Honor, that it is within these
2 quotes that we have and that were stated in our Brief, that there was a long-
3 felt need for improvement for energy efficiency. That was the long-felt
4 need, energy efficiency.

5 Everyone knew that there was heat loss through these hatches and
6 drop down staircases there, so there was a need to improve that, and
7 Mr. Melesky came up with a solution for that.

8 Have I answered your question?

9 JUDGE PATE: Please continue.

10 MR. JANOSKI: We have the next exhibit, Mr. Aleshire, Exhibit E
11 and Exhibit EE, who has conducted tests and evaluation with Oak Ridge
12 Laboratory scientists, and he says the results are three to five times better
13 than any other measure. The results are the direct result of the lid with its lip
14 that fits into the frame on this.

15 JUDGE MCCARTHY: Counsel, is there anywhere we can look in the
16 record to see the test protocols or what the procedure for these tests was?

17 MR. JANOSKI: The tests are in the exhibits, yes, Your Honor. They
18 are there.

19 JUDGE MCCARTHY: Where could I look to find the procedures
20 that were used?

21 MR. JANOSKI: I would say in one instance you would go to Exhibit
22 P. That would have the procedures in there and the results.

23 JUDGE MCCARTHY: That's on the supplemental?

24 MR. JANOSKI: The supplemental, yes, Your Honor. I know there's
25 another one that has --

1 JUDGE PATE: There's an Exhibit EE, a letter from Mr. Aleshire.

2 MR. JANOSKI: Yes.

3 JUDGE PATE: That talks about Oak Ridge, but there's not a
4 declaration from Mr. Aleshire, is there?

5 MR. JANOSKI: No, there is only these letters which were
6 contemporaneous with things that -- there are two letters from Mr. Aleshire,
7 but there is not a sworn declaration from Mr. Aleshire.

8 JUDGE PATE: So we really don't have anybody that was at these
9 experiments or witnessed it first hand, right?

10 MR. JANOSKI: That's true, but these are the results that these experts
11 are reporting as to the results that were achieved with this particular device.
12 I know that the Examiner made a point that it doesn't track the claim
13 language. Well, these letters, again, letters, the statements, when many of
14 them were made, the patent wasn't even public.

15 So there would have been no way that they would have been able to
16 track the claim language in this, but they are referring -- again, that's why I
17 have this model.

18 This is the embodiment that was being used and that everyone is
19 referring to.

20 JUDGE PATE: We don't necessarily have to have it track the claim
21 language, but it would be important for somebody that was at the
22 experiments to describe exactly what was tested. That it had this L-shape
23 orthogonal seal in it, something to that effect.

1 I mean, it doesn't have to track the claim language. We have to be
2 able to recognize the subject matter that was tested is the same one that's
3 claimed.

4 MR. JANOSKI: I understand, and this, though, is the subject matter.
5 This model, which is an embodiment of Claim 14, and is referenced in each
6 one of the exhibits that we have. That is, in fact, referenced there,
7 specifically, the Energy Guardian Kit or describes the seals.

8 So I believe we do meet that requirement, Your Honor, for that.
9 That's why I think it was important to have this model here to show that it is
10 in Figures 1 and 4, and in the photographs, and there are photographs in
11 connection with these, of the actual device, as opposed to the model we have
12 here.

13 But there is reference to this specific model, and as you can see, the
14 specific model does embody Claim 14, and that's what was being tested --
15 this right here -- when they say the Energy Guardian Kit. That's what I
16 would submit.

17 Again, we have people from the Weatherization Manager in Exhibit
18 R. We have the president of a heating and cooling company, Exhibit C,
19 where he says: "I have been in the business for 27 years, and there's nothing
20 to compare with your product. It can save energy and improve the comfort
21 of the home owners." Again, all of these are of record with regard to the
22 supplemental affidavits.

23 In addition, this embodiment, this device, has received many awards
24 and recognitions from the Kruetztown University award for environmental
25 efficiency, the Pennsylvania governor's award for environmental excellence,

1 and these are all in Exhibit GG, Exhibit A, Exhibit T. It's been featured on
2 TV several times. It just is that it is significant, and it has received much
3 acclaim in this regard because of the unexpected results that have been
4 achieved by Mr. Melesky's device.

5 JUDGE MCCARTHY: Counsel, if you could tie it together for us,
6 could you tell us when we weigh your evidence, and the references given by
7 the Examiner, why the Examiner's references do not outweigh the probative
8 value of the evidence that you've given us?

9 MR. JANOSKI: The Examiner's does not outweigh the probative
10 value because it does not show -- I guess to sum it up here -- Waters is a
11 frame that just has a sheet that lays on top of it and is hinged.

12 What Helbig shows is a cover, but the cover sits on top of the frame.
13 It does not sit within the frame.

14 The key to this is the placement of the downwardly depending portion
15 within the frame is what creates the seal -- one of the two seals. Then the
16 second one is on top.

17 What I think -- when you look at Figure 7 by itself, without looking at
18 Figure 6, you would say, well, there's two frames that go around.
19 You have the joist, which are 26, and you have the other frame, which is 12.
20 But when you look at Figure 6, you can see the joists are just parallel. They
21 create an anchor for the frame, and they do not form a seal there.

22 It is a position where it does not have a frame as, again, is required by
23 the claim elements with ends and sides. It has ends, but it doesn't have sides.
24 So it would not be obvious -- one would not be motivated -- to now place
25 something within the frame. I think they weren't placing anything within the

1 frame because you have the ladder that was coming up, and they didn't want
2 it to hit the ladder. So they were placing it on the frame. They were placing
3 it on top of the frame, but not within the frame.

4 This placing within the frame was the first time that we actually got a
5 situation where now we had seals. We are now restricting the air flow from
6 going between the attic and the room below.

7 JUDGE PATE: One more question, if I may. Going back to the
8 language of Claim 14, what is it about the term "a continuous frame" that
9 excludes the joists from the scope of that term?

10 MR. JANOSKI: It says a continuous frame having spaced side walls
11 and spaced end walls. So it's defined -- the continuous frame -- as being
12 square or rectangular.

13 So the two joists, if you will -- here, I guess is where they would be --
14 without the sides is not a continuous frame as that is defined in the claim
15 language.

16 JUDGE PATE: But isn't the term "having open-ended" wouldn't it
17 permit extra structures such as the joists?

18 MR. JANOSKI: I don't think that it would permit extra structures
19 such as joists because it's very specific here, Your Honor, as to what it is
20 required to have. That is side and ends on this, and that is the only way that
21 you're going to get, again, the continuous seals that are required.

22 JUDGE PATE: Let's look at this Figure 7 of Helbig again. It shows
23 that Member 12, it shows one on the end and one on the side. It looks like
24 that Member 12 is rectangular and goes all the way around the thing.

25 MR. JANOSKI: Right.

1 JUDGE PATE: Okay. And isn't 24 resting on that?

2 MR. JANOSKI: No, 24 --

3 JUDGE PATE: Well, it looks like it's resting in Figure 7.

4 MR. JANOSKI: Yes, Your Honor, you're exactly right. 24 does rest
5 on it, it does not rest within it, as is required within the frame as is required
6 by the claim language.

7 JUDGE PATE: So you're saying that 28 only rests on the joist and
8 not on the member 12 on the sides? Is that what you're saying?

9 MR. JANOSKI: Correct, that's exactly right. Yes, Your Honor.

10 JUDGE PATE: I can see that.

11 MR. JANOSKI: 28 is on just the two joists, where element 24 is on
12 the frame.

13 There is nothing to suggest to anyone with these two references to
14 place anything within the frame. Any of these elements within the frame to
15 where it would be against the frame, such as is shown here in the
16 embodiment that we have. To fit in there snugly.

17 In both instances, it's on top of it. It's not within the frame. It took me
18 a little while to understand that --

19 JUDGE PATE: This is the first time that I've understood the
20 argument exactly. It's in the frame on the sides, but not all the way around.

21 MR. JANOSKI: Correct.

22 JUDGE PATE: I don't think that argument is made in the Brief.
23 There's one place right before Subsection A -- you know, the final
24 arguments in the Brief A, B, C, D, and E, and continuous is not one of them.

1 It's right before that Section A where it talks about continuous there, but,
2 you know, it might be in the Reply Brief. I'll go and check that.

3 MR. JANOSKI: I believe it is in there -- respectfully believe it's in
4 there, Your Honor.

5 JUDGE PATE: Okay. Do you have any more questions?

6 JUDGE MCCARTHY: No.

7 JUDGE STAICOVICI: No.

8 JUDGE PATE: We have no more questions for you, and we're over
9 time already. We're going to take this case under advisement.

10 MR. JANOSKI: Thank you very much, Your Honors, for your time.
11 (Whereupon, the proceedings at 9:28 were concluded.)